

Hearing:
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Paper No. 28
RLS/cv

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB

SEPT 24, 98

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Celestial Seasonings, Inc.
v.
J. L. Franklin & Co., dba Gelato Amare

Opposition No. 96,065
to application Serial No. 74/397,075
filed on June 2, 1993

William T. Gallagher of Townsend and Townsend for Celestial Seasonings, Inc.

David E. Bennett of Rhodes, Coats & Bennett LLP for J. L. Franklin & Co., dba Gelato Amare.

Before Simms, Hohein and Walters, Administrative Trademark Judges.

Opinion by Simms, Administrative Trademark Judge:

Celestial Seasonings, Inc. (opposer), a Delaware corporation whose principal place of business is in Boulder, Colorado, has opposed the application of J. L. Franklin & Co., doing business as Gelato Amare (applicant), a North Carolina corporation, to register the mark SORBETTO ZINGER for slush shake made with Italian ice and carbonated

beverages.¹ Opposer has asserted in the notice of opposition that applicant's mark used in connection with its goods so resembles the marks ZINGER, RED ZINGER, LEMON ZINGER, ORANGE ZINGER, WILD BERRY ZINGER, RASPBERRY ZINGER and ORANGE MANGO ZINGER, previously used (and some registered) for various tea products, as to be likely to cause confusion, to cause mistake or to deceive. In its pleading, opposer has asserted that the public has come to associate the "ZINGER" marks with it, that opposer has developed a family of "ZINGER" marks and that these marks are "famous and well known." In its answer, applicant has denied the essential allegations of the notice of opposition.

Opposer's Record

Only opposer has taken testimony and introduced other evidence in its behalf. In this regard, opposer has taken testimony and submitted a notice of reliance upon applicant's responses to certain discovery requests, on six registrations, and on various articles from printed publications. The registrations cover the marks LEMON ZINGER for herb tea, "LEMON" disclaimed (Registration No. 1,390,142, issued April 15, 1996, Sections 8 and 15 affidavit filed); RED ZINGER for herb tea, "RED" disclaimed (Registration No. 1,390,146, issued April 15, 1996, Sections

¹ Application Serial No. 74/397,075, filed June 2, 1993, based

8 and 15 filed); ORANGE ZINGER for herb tea, "ORANGE" disclaimed (Registration No. 1,481,773, issued March 22, 1988, Sections 8 and 15 filed); ZINGER for herb tea (Registration No. 1,515,651, issued December 6, 1988, Sections 8 and 15 filed); and WILD BERRY ZINGER for herb tea, "WILD BERRY" disclaimed (Registration No. 1,834,824, issued May 3, 1994). Opposer has also introduced a registration covering the mark RED ZINGER for promoting and conducting professional bicycle races.

According to the testimony of Dr. Lindsay Moore, opposer's Director of Creativity and an employee of opposer since 1974, opposer introduced its first "ZINGER" product in 1972--RED ZINGER herb tea. The LEMON ZINGER herb tea product was introduced in 1985 and other products followed--ZINGER, ORANGE ZINGER (subsequently discontinued), ORANGE MANGO ZINGER, WILD BERRY ZINGER, RASPBERRY ZINGER, CRANBERRY ZINGER and MANTANGO ZINGER, the last three being ready-to-drink tea products. These herb tea products are sold in all 50 states and internationally. In the United States, they are sold in grocery stores, health food stores, some gift shops, gourmet stores and some drugstores. Dr. Moore also testified that opposer's teas are available in restaurants (dep., 12).

upon applicant's claim of use in commerce since October 1, 1992.

In the 1970s, opposer also introduced a product called RED ZINGER Rocky Mountain Thirst Quencher (dep., 43). This product was apparently offered until 1983. In 1992, opposer introduced a product called LEMON ZINGERADE, a ready-to-drink product, sold in grocery stores, convenience stores, some health food stores and restaurants. Also, since 1984 opposer has also sold frozen iced tea pops (under a different mark).

At its headquarters in Boulder, Colorado, opposer opened the Celestial Café in September 1992 (dep., 57). Approximately 70,000 to 100,000 people per year frequent this café. According to Dr. Moore, at this café there is a ZINGERADE iced tea dispenser as well as a frozen yogurt dispenser which dispenses a tea-flavored frozen yogurt.

Sales of opposer's ZINGER products over the years have exceeded \$105 million (dep., 14). Opposer has advertised its products in the print media and on television, has sent samples of its products to at least 1.5 million people, has distributed millions of coupons and has sold under its ZINGER marks such promotional items as trays, travel mugs, refrigerator magnets, posters, canisters, placemats, calendars, sweatshirts and water bottles. Bicycle jerseys and uniforms for its international race team members have also been distributed in connection with the RED ZINGER Bicycle Classic, a professional bicycle race started in

1975. According to Dr. Moore, there is also a RED ZINGER ski trail at the Vail Ski Resort, a use permitted through a licensing arrangement. With respect to the renown of its marks and the question of confusion, Dr. Moore testified, 68-69:

I'd like to comment on the miraculous history of our Zinger name, which was initiated with the Red Zinger products which commonly have a product life which begins low, goes up high, falls, only to be replaced by another product. Red Zinger has been a miraculous product for this organization since its inception. It's climbed up high, it's stayed in our top 10 products for 25 years now and has never fell [sic] down below its high on the chart marking. It has become a classic in the organization from a marketing perspective, because few products that any company ever has has [sic] attained this level of notoriety in recognition both domestically and internationally...

...We have expanded it to many other products, both within our hot tea product line and our ready-to-drink product line, numbering, in total, 9 or 10 products carrying the Zinger name at this time...

Without a doubt, [applicant's mark is] harmful to our mark. Our products are sold as hot teas and iced teas and ready-to-drink teas, and we also sell products as Popsicles, as Ice Pops. So I think it must be confusing to people who would go into these stores to find that product listed there. They wouldn't be at all surprised to see either a frozen product or an iced tea product or a ready-to-drink product, all of which are cold products from Celestial Seasonings under the 'Zinger' mark.

The answers to opposer's discovery requests reveal that the mark SORBETTO ZINGER is used in connection with a "slush drink similar to a milkshake made with sorbetto (Italian ice) and sprite [sic]." See Responses to Interrogatory Nos. 1 and 8. The responses also indicate that, prior to 1992,

applicant's goods were marketed under the "descriptive name" Sorbetto Slush. Further, applicant indicates that the goods are sold in ice cream parlors, with sales averaging around \$2,000 per year.

Arguments of the Parties

Opposer argues that it has established a family of ZINGER marks which is strong and famous, the first ZINGER mark being used in the 1970s. Except for the mark ZINGER per se, opposer argues that its family of marks consists of the arbitrary word ZINGER preceded by a flavor, color or other descriptive term. Opposer argues that applicant's mark is similarly structured, consisting of a descriptive food term (SORBETTO, meaning "sorbet") plus the term ZINGER. Opposer also notes that there is no evidence of any third-party use of similar marks. Concerning the goods, opposer argues that, by a natural expansion of its business, it now sells chilled ready-to-drink products as well as iced tea pops which are flavored with tea. Opposer argues that applicant's slush-type shake as well as opposer's beverages are all refreshing non-alcoholic beverages. Opposer also notes that there is no limitation in the identification of goods in applicant's application. Applicant's goods must, therefore, be presumed to move through all ordinary and usual channels of trade to all usual customers. Applicant's

slush-type shake, accordingly to opposer, could well be sold in the dairy or frozen food sections of grocery stores.

While applicant concedes that opposer has established a family of ZINGER marks, applicant denies that opposer's marks are strong or famous. Instead, applicant contends that opposer's marks are "descriptive or highly suggestive" (brief, 6) because "zinger" is a derivative of "zingy," meaning sharply piquant. Applicant also argues that there is no probative evidence concerning the extent of opposer's advertising of its marks. While applicant concedes that both parties sell beverages, applicant contends that its slush-type drink is a made-to-order drink sold exclusively in ice cream parlors and is not packaged for sale. Opposer goods, on the other hand, are sold to retail outlets and in restaurants.²

Opinion

The record, including opposer's valid and subsisting registrations, establishes opposer's priority. Upon careful consideration of this record and the arguments of the attorneys, we agree with opposer that confusion is likely.

First, opposer has demonstrated use of a group of marks

² Applicant raises several objections to opposer's record. Applicant's objections are overruled. We believe that the witness was sufficiently responsible for the marketing materials and print advertisements and had personal knowledge concerning the relevant facts in this case. We also believe that the printed publications tend to show the recognition and strength of opposer's marks. They are not being submitted for the truth of the matter asserted therein.

with a recognizable common characteristic. See *J & J Snack Foods Corp. v. McDonald's Corp.*, 932 F.2d 1460, 18 USPQ2d 1884 (Fed. Cir. 1991). We agree with opposer that the public, familiar with opposer's family of well-known ZINGER marks used in connection with herb tea and, more recently, its chilled drinks and frozen snacks, are likely to believe that applicant's SORBETTO ZINGER slush shake, because of the similarities of the marks, is a product which is endorsed by, sponsored by or otherwise associated with opposer. In this regard, we note, as did opposer, that we must reach a conclusion on the issue of likelihood of confusion on the basis of the description of goods in the application, regardless of what the record may reveal as to the particular nature of applicant's goods and the particular channels of trade in which they actually travel. See *Octocom Systems v. Houston Computer Services, Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990). We see nothing inherent in the description of applicant's goods that would limit their sale to ice cream parlors. These goods could be sold in the frozen drink or chilled beverage sections of grocery stores and supermarkets. However, even if we must assume that applicant's goods could only be available in a food service establishment, we nevertheless believe that, because of the similarities of the marks, the purchasing public may well believe that applicant's SORBETTO ZINGER

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shakes come from or are endorsed by or sponsored by opposer. We have also taken into consideration the fact that the respective goods are relatively inexpensive and may be the subject of impulse purchases made without great care as to the source or origin of the products.

Decision: The opposition is sustained and registration to applicant is refused.

R. L. Simms

G. D. Hohein

C. E. Walters
Administrative Trademark Judges,
Trademark Trial and Appeal Board